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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Raymond J. Kelley et al.

Serial No.: 09/747,041

Filed: December 22, 2000

For: Web-based Medical Diagnostic
System Financial Operation
Planning System and Method

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Group Art Unit: 3628

Examiner: Fults, Richard C.

Atty. Docket: GEMS:0122/YOD/SWA/
15-EC-5773

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February 2, 2005

Date

Tait R. Swanson

Sir:

EXAMINER INTERVIEW SUMMARY

On February 2, 2005, the Applicants' representative, Tait R. Swanson (Reg. No. 48,226) engaged in an Examiner Interview to discuss the finality of the previous Office Action mailed on October 8, 2004. During this interview, the **Examiner agreed to remove the finality** of the Office Action mailed on October 8, 2004, based on the lack of proper rejections of the dependent claims. In view of the withdrawn finality of the previous Office Action, the Examiner also agreed to enter the new claims and consider the remarks set forth in the Amendment and Response filed on December 7, 2004. The Examiner also agreed to issue a new non-final Office Action specifically addressing the features recited in the dependent claims.

In addition, the Applicants' representative emphasized the previous challenge against the Examiner's use of Office Notice, as set forth on pages 13-15 of the previous Amendment and Response filed on December 7, 2004. More specifically, as emphasized

in the previous Amendment and Response, Section 2144.03 of the Manual of Patent Examining Procedure specifically states:

In **limited circumstances**, it is appropriate for an examiner to take office notice of facts not in the record or to rely on “common knowledge” in making a rejection, however such rejections should be **judiciously applied**.

...
Office notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “office notice” may be relied on, these **circumstances should be rare** when an application is under final rejection or action under 37 CFR 1.113.

...
As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be “**capable of such instant and unquestionable demonstration as to defy dispute**” (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

...
For example, assertions of technical facts in the areas of esoteric technology or **specific knowledge of the prior art must always be supported by citation to some reference work** recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21.

...
In re Eynde, 480 F.2d 1364, 1370, 178 USPQ 470, 474 (CCPA 1973) (“[W]e reject the notion that judicial or administrative notice may be taken of the state of the art. The **facts constituting the state of the art** are normally subject to the possibility of rational disagreement among reasonable men and are **not amenable to the taking of such notice**.”).

...
Furthermore, as noted by the court in *Ahlert*, any facts so noticed should be of notorious character and **serve only to “fill in the gaps” in an insubstantial manner** which might exist in the evidentiary showing made by the examiner to support a particular ground for rejection.

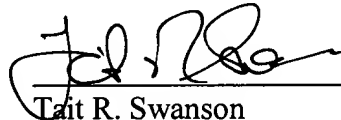
M.P.E.P. (Rev. 2, May 2004) § 2144.03, Pages 2100: 136-138. In view of these passages, the Examiner’s use of Office Notice is improper and cannot stand, because the scope of the Office Notice is far beyond an *insubstantial gap* in the Erwin reference. In fact, the Examiner appears to be rejecting the *entire claims* based on Office Notice. Moreover, the Examiner’s Office Notice refers to the *general state of the art*, which the foregoing legal precedent clearly precludes. For these reasons, the Applicants respectfully request

evidence to support the Examiner's Office Notice, so that the record is complete and clear as to all matters. If the Examiner cannot provide such supporting evidence, then the Applicants respectfully request withdrawal of the Examiner's Official Notice. On the other hand, if the Examiner finds a reference and applies it in combination with the Erwin reference, Applicants further request that the Examiner specifically identify the portion of the newly cited reference that discloses the allegedly "well known" elements of the recited claims. If the Examiner disagrees or refuses to search for such supporting evidence, then the Applicants respectfully request an interview with the Examiner's supervisor at his earliest convenience.

The Applicants respectfully submit that all pending claims should be in condition for allowance. However, if the Examiner believes certain amendments are necessary to clarify the present claims or if the Examiner wishes to resolve any other issues by way of a telephone conference, the Examiner is kindly invited to contact the undersigned attorney at the telephone number indicated below.

Respectfully submitted,

Date: February 2, 2005



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